


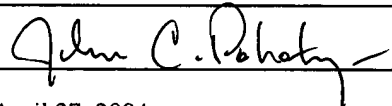
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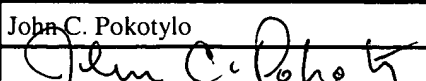
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Modified PTO/SB/21 (08-00)
Approved for use through 10/31/2002. OMB 0651-0031
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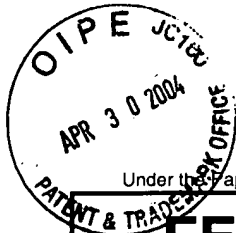
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|--|-----------------------------|-------------------------------|------------|
| TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i> | Application Number | 09/400,034 | |
| | Filing Date | September 21, 1999 | |
| | First Named Inventor | Ralph K. ITO | |
| | Group Art Unit | 1723 | |
| | Examiner Name | Matthew O. Savage | |
| Total Number of Pages in This Submission | | Attorney Docket Number | Olympus-13 |

| ENCLOSURES <i>(check all that apply)</i> | | |
|---|--|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Assignment Papers <i>(for an Application)</i> <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i> <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Postcard Receipt <input type="checkbox"/> Other Enclosure(s) <i>(please identify below):</i> |
| Remarks | | |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | |
|--|---|
| Firm or Individual name | John C. Pokotylo (Reg. No. 36,242) |
| Signature |  |
| Date | April 27, 2004 |

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| Typed or printed name | John C. Pokotylo | | |
| Signature |  | Date | April 27, 2004 |

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Modified PTO/SB/17 (01-03)
Approved for use through 04/30/2003. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

FEE TRANSMITTAL for FY 2004

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 00.00

Complete if Known

| | |
|----------------------|--------------------|
| Application Number | 09/400,034 |
| Filing Date | September 21, 1999 |
| First Named Inventor | Ralph K. ITO |
| Examiner Name | Matthew O. Savage |
| Art Unit | 1723 |
| Attorney Docket No. | Olympus-13 |

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit
Account
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50-1049

Straub & Pokotylo

The Commissioner is authorized to: (check all that apply)

☐ Charge any underpayment of fee(s) indicated below ☐ Credit any overpayments

☒ Charge any additional fee(s) due in connection with the filing submitted herewith

☐ Charge fee(s) indicated below, except for the filing fee in the to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|------------------------|-------------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1001 | 770 | 2001 | 385 | Utility filing fee | |
| 1002 | 340 | 2002 | 170 | Design filing fee | |
| 1003 | 530 | 2003 | 265 | Plant filing fee | |
| 1004 | 770 | 2004 | 385 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |
| SUBTOTAL (1) | | | | | (\$) 00.00 |

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Extra Claims Fee from below Fee Paid

Total Claims -20** = X =

Independent Claims -3** = X =

Multiple Dependent =

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|---|-------------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 | |
| 1201 | 86 | 2201 | 43 | Independent claims in excess of 3 | |
| 1203 | 290 | 2203 | 145 | Multiple dependent claim, if not paid | |
| 1204 | 86 | 2204 | 43 | **Reissue independent claims over original patent | |
| 1205 | 18 | 2205 | 9 | **Reissue claims in excess of 20 and over original patent | |
| SUBTOTAL (2) | | | | | (\$) 00.00 |

**or number previously paid, if greater, For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description | Fee Paid |
|----------|----------|----------|----------|--|----------|
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for ex parte reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | |
| 1252 | 420 | 2252 | 210 | Extension for reply within second month | |
| 1253 | 950 | 2253 | 475 | Extension for reply within third month | |
| 1254 | 1,480 | 2254 | 740 | Extension for reply within fourth month | |
| 1255 | 2,010 | 2255 | 1,005 | Extension for reply within fifth month | |
| 1401 | 330 | 2401 | 165 | Notice of Appeal | |
| 1402 | 330 | 2402 | 165 | Filing a brief in support of an appeal | |
| 1403 | 290 | 2403 | 145 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive - unavoidable | |
| 1453 | 1,330 | 2453 | 665 | Petition to revive - unintentional | |
| 1501 | 1,330 | 2501 | 665 | Utility issue fee (or reissue) | |
| 1502 | 480 | 2502 | 240 | Design issue fee | |
| 1503 | 640 | 2503 | 320 | Plant issue fee | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(c) | |
| 1806 | 180 | 1806 | 180 | Submission of Information Disclosure | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 770 | 2809 | 385 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 | 770 | 2810 | 385 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 1801 | 770 | 2801 | 385 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify) _____

* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 00.00

SUBMITTED BY

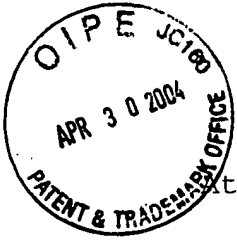
(Complete if applicable)

| | | | | | |
|-------------------|------------------|-----------------------------------|----------------|-----------|----------------|
| Name (Print/Type) | John C. Pokotylo | Registration No. (Attorney/Agent) | 36,242 | Telephone | (732) 542-9070 |
| Signature | | Date | April 27, 2004 | | |

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AF/1723 IFW



**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Attorney Docket No.: **Olympus-13**

Applicant: **Ralph K. ITO**

Serial No.: **09/400,034**

Filing Date: **September 21, 1999**

Title: **METHODS AND APPARATUS FOR PREPARING A FLUID SAMPLE
ALIQUOT**

Examiner: **Matthew O. Savage**

Group Art Unit: **1723**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

REPLY BRIEF

Further to the Examiner's Answer (Paper No. 022004) mailed on February 27, 2004, which set a period of response to expire on April 27, 2004, the applicant requests that the Board further consider this Reply Brief.

Argument

The arguments made by the applicant in the Appeal Brief are maintained and incorporated herein by reference. This Reply Brief is intended to supplement, not replace, the Appeal Brief.

Claim 1 of Group I

Independent claim 1 is not anticipated by the Ruediger patent because the Ruediger patent does not teach a **constricted passage**, arranged between a channel and a support, **for collapsing a pipette tip of a first part as the first part is inserted into the second part.** Recall that the Ruediger patent describes a valve block C used to dispense, or not dispense, fluid from reactor vessels 10, via outlet tubes 52, into wells 12 of a collection block D. (See, e.g., Figure 1 and column 8, lines 43-51.) Leur tip adapters 56 are used to fluidly couple the reactor vessels 10 with outlet tubes 54. (See, e.g., column 9, lines 48-55 and Figure 4.) More specifically, as shown in Figures 4, 6 and 8, as a slide 44 is moved by a threaded screw 74, each of its spaced, downwardly extending, ribs 66 force a resilient member 68 into an outlet tube 54 arranged between it and a corresponding upward extending rib 62 of a bottom plate 40. This structure operates to form a "pinch valve". (See, e.g., column 9, line 39 through column 10, line 55.) As can be appreciated from this disclosure, as well as reference to Figures 6 and 8, the outlet tube 54 is pinched **after** it has already been situated. (See, e.g., column 10, lines 6-10.) It is not collapsed **as** it is inserted.

In the Examiner's Answer, the Examiner makes two counterarguments. First, the Examiner contends:

the functional limitation "for collapsing a pipette tip of a first part as the first part is inserted into the second part" of claim 1 is broad enough to include the procedure of collapsing the pipette tip **after** situating the pipette tip into a

restricted passage having an adjustable cross section as disclosed by Ruediger et al since the word "as the first part is inserted into the second part" can be broadly interpreted as meaning "while the first part is inserted into the second part." [Emphases added.]

(Paper No. 022004, page 6.) By proposing the application of such a broad interpretation, the Examiner is, in effect, asking the Board to ignore an important recitation in the claim. That is, under the interpretation proposed by the Examiner, the recitation

constricted passage, arranged between a channel and a support, for collapsing a pipette tip of a first part as the first part is inserted into the second part

would, in effect, simply be interpreted as:

constricted passage, arranged between a channel and a support, for collapsing a pipette tip of a first part.

The applicant respectfully submits that the claimed feature should be given its ordinary meaning, as understood by those skilled in the art, consistent with the objectives and purposes of the invention (See, e.g., the title, "METHODS AND APPARATUS FOR PREPARING A FLUID SAMPLE ALIQUOT". Emphasis added.), rather than applying a proposed interpretation that would, in effect, remove claim language from consideration.

Second, the Examiner argues in the alternative:

that the sequence of events implied by the by the phrase "as the first part is inserted into the second part" carries no patentable weight because it relates to the intended use of an apparatus having the same structure to the extent recited in instant claim 1.

(Paper No. 022004, pages 6 and 7.) The applicants note that the language defines a structural relationship between the constricted passage of the second part and the pipette tip of the first part, and is therefore not merely reciting an intended use. Further, the case law makes clear that there is nothing wrong with defining something by what it **does** rather than by what it **is**. See, e.g., In re. Swinehart, 169 U.S.Q.P. 226, 228 (CCPA 1971). Finally, as set forth in detail in the Appeal Brief, the claimed structure is not the same as that in the Ruediger patent.

In view of the foregoing, the applicant respectfully submits that the Board should reject the Examiner's proposals to ignore an important claim recitation.

Group IV: Claim 53

Claim 53 is not anticipated by the Ruediger patent because the Ruediger patent does not disclose a pipette **tip** that is tapered. In the Examiner's Answer, the Examiner clarified that his position is that element 54 is the pipette tip, and stated:

the pipette 54 is tapered since it includes a tapered portion **between an upper larger diameter part receiving a lower end of part 56 and a lower smaller diameter part** that is received within the constricted passage.
[Emphasis added.]

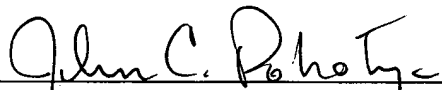
(Paper No. 022004, page 9.) Apparently, the Examiner is referring to the cross section of FIG. 8 of the Ruediger patent. As the quoted language of the Examiner's argument shows, the Examiner is ignoring the term "tip" in the phrase "pipette tip". The ordinary meaning of tip is the end of an object, especially a pointed or projecting object. A portion of element 54 in the Ruediger patent that is "between" an upper part and a lower part is clearly not a tip.

Conclusion

In view of the earlier filed Appeal Brief, in addition to the foregoing argument which supplements that Appeal Brief, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicant requests that the Board reverse each of the outstanding grounds of rejection.

Respectfully submitted,

April 27, 2004


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John C. Pokotylo
John C. Pokotylo

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Reg. No.